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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215553
Party	Defendant Ebel International Limited
Correspondence Address	Mauricio Muniz O'Neill & Borges LLC 250 Munoz Rivera Ave., Ste 800 San Juan, PR 00918-1813 tmproceedings@oneillborges.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Mauricio O. Muniz Luciano
Filer's e-mail	mauricio.muniz@oneillborges.com, travis.wheatley@oneillborges.com, tmproceedings@oneillborges.com
Signature	/Mauricio O. Muniz Luciano/
Date	04/30/2014
Attachments	Motion to Dismiss- SUMMUM L'BEL (00141594xC536D) - MOM Rev.pdf(365306 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Guinot, a French societe par)	
Actions simplifee,)	
)	<u>MOTION TO DISMISS</u>
Opposer,)	
)	Opposition No. 91215553
v.)	Serial No. 85840883
)	Mark: SUMMUM L'BEL
Ebel International Limited)	
Applicant)	

**APPLICANT'S MOTION TO DISMISS
OPPOSITION FOR FAILURE TO STATE A CLAIM**

COMES NOW, Applicant, Ebel International Limited ("Applicant" or "Defendant"), by its undersigned counsel and respectfully states:

PRELIMINARY STATEMENT

Applicant hereby moves pursuant to Fed.R.Civ.P. 12(b)(6) and TBMP §503 to dismiss the Notice of Opposition No. 91215553 (the "Complaint") filed by Opposer, Guinot ("Plaintiff" or "Opposer"), because it fails to state a claim upon which relief may be granted. A cursory review of the Complaint makes it evident that Plaintiff's request regarding Applicant's registration of the trademark SUMMUM L'BEL (the "Applicant Mark") based on, among other things, Plaintiff's alleged ownership of the trademark "SUMMUM" (the "Opposer Mark") in a European country (not the United States), cannot survive the instant motion to dismiss.

MEMORANDUM IN SUPPORT OF REQUEST FOR DISMISSAL

TBMP § 506.01 provides that a party may assert the defense that there has been a "failure to state a claim upon which relief can be granted." TBMP § 503; see also Fed.R.Civ.P. 12(b)(6). On this basis, Applicant requests the dismissal of the Complaint because it fails to state a claim upon which relief can be granted. Specifically, TBMP § 503.02 provides that: "Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought." TBMP § 503.02. Applicant submits that even in light of this demanding standard, the Complaint does not contain any allegations, which if even proved, would entitle the Plaintiff to the relief sought. To the contrary, the Complaint contains admissions that should move this Honorable Board to dismiss the Complaint.

DISCUSSION

Applicant submits that the grounds for opposing Applicant's Mark, as mentioned in the cover sheet to the Complaint, or stated or even implied in the Complaint, are not supported by the simple allegations contained therein and, thus, no claim upon which relief can be granted has been stated.

A. False Suggestion of a Connection

One of the claims asserted by Plaintiff is that if Applicant's application "matured into a registration [it] will represent a false connection with Opposer." Opposition, ¶ 8. However, as pleaded in the Opposition, this claim must be dismissed.

Section 2(a) of the Lanham Act, provides:

[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.).

15 U.S.C. § 1052.

Similarly, Section 1203.03(c)(i) of the TMEP (citing applicable case law) provides the necessary elements for a claim of false connection:

[t]o establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that:

- 1 the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- 2 the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- 3 the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and
- 4 the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

TMEP § 1203.03(c)(i). See In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG, 103 USPQ2d 1417, 1419 (TTAB 2012); In re Peter S. Herrick, P.A., 91 USPQ2d 1505, 1507 (TTAB 2009);

In re MC MC S.r.l., 88 USPQ2d 1378, 1379 (TTAB 2008); Association Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk, 82 USPQ2d 1838, 1842 (TTAB 2007); In re White, 80 USPQ2d 1654, 1658 (TTAB 2006); In re White, 73 USPQ2d 1713, 1718 (TTAB 2004); In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 (TTAB 1990); Buffett v. Chi-Chi's, Inc., 226 USPQ 428, 429 (TTAB 1985); In re Cotter & Co., 228 USPQ 202, 204 (TTAB 1985); see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

In view of the above, to properly plead false suggestion of connection, Opposer must also allege that it has either made prior use of the Applicant Mark to designate Opposer's identity, or that the Applicant Mark has become associated with Opposer prior to Applicant's use of it. See Ala. Bd. Of Trs. v. BAMA-Werke Curt Baumann, 231 U.S.P.Q. 408 (T.T.A.B. 1986).

In its Opposition, Opposer has cannot claimed that the Applicant Mark is "the same as, or a close approximation of, the name or identity previously used by" Opposer in the United States. Opposer has not claimed that the Opposer Mark "would be recognized as such, in that it points uniquely and unmistakably to" Opposer in the United States. Opposer has not claimed that "the fame or reputation of [Opposer] is such that, when the mark is used with [Applicant's] goods or services, a connection with Opposer would be presumed". More importantly, Opposer has failed to show that it has made prior use in the United States of the Applicant Mark to designate Opposer's identity, or that the Applicant Mark has become associated with Opposer prior to Applicant's use.

Accordingly, Applicant respectfully submits that no claim upon which relief may be granted has been stated in connection with the alleged ground of "false suggestion of a connection" and that this ground should be dismissed.

B. Priority and Likelihood of Confusion

Another ground for opposition of Applicant's Mark is that "the likelihood of confusion in the marketplace exists between Opposer's trademark when applied to the goods of the respective parties, and applicant's trademark." Opposition, ¶ 7. There are no other statements contained in the Opposition that support this mere recitation of the definition of likelihood of confusion. Thus, this claim is also without merit and should be dismissed.

In order to properly set forth a claim of likelihood confusion, Opposer must first plead that it has proprietary rights on its pleaded mark whether by ownership of a registration, prior use of a technical trademark, prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity, that are superior to those of the Applicant. See Otto Roth & Co. Universal Foods Corp., 640 F. 2d 1317, 209 U.S.P.Q. 40 (C.C.P.A. 1974). To properly allege superior proprietary rights in connection with common law rights, Opposer must also plead priority of use or use of analogous to trademark use and either inherent or acquired distinctiveness of its mark in the United States. In the case of acquired distinctiveness, Opposer must alleged facts sufficient to show, if proven, that the ordinary customer associates the mark with a single, though anonymous source.

Even if secondary meaning is proven by evidence other than actual confusion, this does not necessarily mean that confusion is likely. Evidence of confusion is also evidence of secondary meaning, but evidence of secondary meaning is irrelevant to the issue of validity of a trademark. See Freixenet, S.A. v. Admiral Wine & Liquor Co., 731 F.2d 148, 151, 222 U.S.P.Q. 770 (3d Cir. 1984). (“Regardless of how much secondary meaning it possesses, a product’s trade dress will not be protected from an imitator that is sufficiently different in its features to avoid confusion.”)

On the other hand, if Plaintiff has not obtained secondary meaning in a non-inherently distinctive designation, then another use of that designation cannot possibly result in a buyer’s confusion. See Sno-Wizard Mfg., Inc. v. Eisenmann Products Co., 791 F.2d 423, 428, 230 U.S.P.Q. 118 (5th Cir. 1986); Universal Frozen Foods, Co. v. Lamb-Weston, Inc., 697 F. Supp. 389, 394, 7 U.S.P.Q. 2d 1856 (D. Or. 1987) (“Preliminarily, I note that Professor McCarthy’s testimony is persuasive that proof of secondary meaning is a condition precedent to any discussion of likely confusion. . . . It follows that a buyer cannot be ‘confused’ where, as here, he or she does not recognize the product shape as a symbol of origin.”); Perini Corp. v. Perini Const., Inc., 915 F.2d 121, 125, 16 U.S.P.Q. 2d 1289 (4th Cir. 1990) (“If a trade name has not acquired secondary meaning, the purchaser will not make an association with a particular producer and thus will not be misled by an identical or similar mark.”); Custom Vehicles, Inc. v. Forest River, Inc., 476 F.3d 481, 484, 81 U.S.P.Q. 2d 1753 (7th Cir. 2007) (Without secondary meaning, there can be no likelihood of confusion: “[Unless Custom Vehicles’ descriptive mark had achieved secondary meaning, a consumer would not associate the name with Custom Vehicles and so could not be confused if someone else used the name.”].)

In the instant proceedings, Plaintiff has failed to state that (a) it is using the Opposer Mark in commerce **in the United States** (not France) or (b) that it has any priority of use over Applicant. To the extent Opposer mentions a use prior to Applicant, it is in connection with use and applications **in Europe**, which is irrelevant to this case because Opposer has made no claims of priority or an earlier effective filing date based on an application filed pursuant to Section 44(e) of the Lanham Act, 15 U.S.C. § 1126. Likewise, Opposer has failed to successfully state that its mark has acquired distinctiveness or secondary meaning.

Moreover, the Complaint should have set forth the basic facts supporting a claim based on likelihood of confusion, which include, allegations as to the similarity of the marks in sight, sound, and/or meaning; similarity of the goods and/or services; similarity of trade channels and classes of purchasers of the goods and/or services; the fame of Opposer’s Mark, the similarity of the conditions under which buyer’s encounter Opposer’s and Applicant’s marks, and the nature and extent of any actual confusion. See In Re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 12973).

In connection with the above, Plaintiff only made the following claim: “Applicant’s mark and Opposer’s trademark are **identical** in sound, spelling, and appearance.” Complaint, ¶ 5. In doing so, Plaintiff alleges that Applicant’s Mark is only the word “SUMMUM”, but very conveniently ignores the complete mark, which is “SUMMUM L’BEL”. In other words, the marks at issue, although they may share one word, are not the same as erroneously alleged by Plaintiff. Evidently, the Applicant Mark and Opposer Mark are not identical in sound, spelling, and/or appearance.

Additionally, Plaintiff acknowledges that the Applicant's Mark was filed "for fragrances and deodorants" and, in contrast, "Opposer's application does not request registration for any fragranced products or deodorants." Complaint, ¶¶ 3 and 4. That is, the Applicant and Opposer Marks are for different products under Class 03. See SUMMUM L'BEL Trademark/Service Mark Application. As the Applicant Mark and Opposer Mark serve as identifier for different types of goods, there could be no factual basis to claim likelihood of confusion of different products between both marks.

In short, Plaintiff in this case has not alleged priority of use of its mark **in the United States**, not in Europe, in order to be able to allege that it has priority of use in the United States, as well as its likelihood of confusion claim. Moreover, the marks are different, as the Applicant's Mark contains the words "SUMMUM L'BEL", and is for different products to those of Plaintiff, there could be no likelihood of confusion, as per the Complaint's own allegations. Thus, Applicant respectfully submits that no claim upon which relief may be granted has been stated in connection with the alleged ground of "priority and likelihood of confusion" and that this ground should be dismissed.

C. Dilution

Section 13 of the Lanham Act provides that an opposition proceeding may be filed by "any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125 (c) of this title [Title 15]". See 15 U.S.C. § 1063. In the instant proceedings, the first fatal flaw of the Complaint is that it fails to state that the Applicant Mark would cause dilution, whether by blurring or tarnishment. Furthermore, under Section 1125(c) of the Lanham Act, dilution, whether by blurring or tarnishment, can only occur when the allegedly diluted mark is famous. See 15 U.S.C. § 1125(c)(2). In this case, Plaintiff has not alleged (and cannot) that its mark is "famous", as required by the statute.

In view of the foregoing, Applicant respectfully submits that no claim upon which relief may be granted has been stated in connection with the alleged ground of "dilution" and that this ground should be dismissed.

D. Allegation that Applicant lacked a bona fide intent to use the mark in commerce at the time of filing

According to Plaintiff, "Applicant lacked a bona fide intent to use the mark in commerce at the time it filed its application to register SUMMUM." Complaint, ¶ 9. To the extent this corresponds to a ground for opposition, Plaintiff is asserting fraud against Applicant in connection with its intent to use filing of the "SUMMUM L'BEL" mark.

The Federal Rules of Civil Procedure are applicable to proceedings before the TTAB, specifically for a claim of fraud like Plaintiff is somehow asserting in its Complaint against Applicant. See TBMP §101.02. Accordingly, Fed.R.Civ.P. 9(b) states that in alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. See Fed.R.Civ.P. 9(b); Denny v. Barber, D.C.N.Y.1976, 73 F.R.D.6 ("Rule 9(b) must be reconciled with Rule 8 and there must be a brief but specific statement of the facts amounting to a claim of fraud."); Producers Releasing Corp. v. Pathe

Indus., Inc. D.C.N.Y.1950, 10 F.R.D.29, 32 (“It is true Rule 9(b) does not abrogate the beneficial provisions of Rule 8 but still, allegations of fraud must be made with particularity.”); In Re GlenFed, Inc. Secs. Litigation, 42 F. 3d 1541 (9th Cir. 1994), citing Wright and Miller (“Rule 9(b) requires more than Rule 8(a). Rule 9(b) serves more than just a notice giving function, it requires particularized allegations of the circumstances constituting fraud.”); and The Bd. of Trustees of the Univ. of Alabama, 231 U.S.P.Q. (BNA) ¶ 408 Trademark Tr. & App. Bd. Aug. 6, 1986 (“We have repeatedly held that the seriousness of the charge of fraud requires that it be “proven to the hilt,” with no room for speculation, inference or surmise. Any doubt must be resolved against the charging party.); see also Pennwalt Corp. v. Sentry Chemical Co., 219 USPQ 542 (TTAB 1983); Bonaventure Associates v. Westin Hotel Company, 218 USPQ 537 (TTAB 1983); and Smith International v. Olin Corp., 209 USPQ 1033, 1044 (TTAB 1981).

Based in the foregoing, broad assertions and conjectures, as Plaintiff has done in the Complaint, are insufficient to assert a fraud claim. Plaintiff’s bald assertion of the alleged fraud by Applicant at paragraph 9 of the Complaint does not contain any of the particularity required in Fed. R. Civ. P. 9(b) and applicable case law. Therefore, even though it is a completely false statement on behalf of Plaintiff,¹ such a claim of fraud without any specifics must be disregarded and dismissed, as mandated by the applicable rules.

Accordingly, Applicant respectfully submits that no claim upon which relief may be granted has been stated in connection with the alleged ground of “Applicant lacked a bona fide intent to use the mark in commerce at the time of filing” and that this ground should be dismissed.

CONCLUSION

Because all of Plaintiff’s grounds for opposition are inadequately plead and fail to state any claim for which relief may be granted as demonstrated above, Applicant respectfully requests that the Board (i) grant this Motion; (ii) dismiss the Opposition; and (iii) grant such other and further relief as the Board deems appropriate.

Respectfully Submitted,

EBEL INTERNATIONAL LIMITED

By: /Mauricio O. Muñiz Luciano/
Mauricio O. Muñiz Luciano

O’Neill & Borges LLC
Attorneys for Ebel International Limited
250 Muñoz Rivera Ave., Suite 800
San Juan, PR 00918

¹ If the Complaint survives the instant motion to dismiss, which it should not, Applicant will prove how its mark is already being used in commerce **in the United States**, which is the relevant country for purposes of the evaluation by the TTAB for this proceeding (not France or any other European country), as well as it has other registrations in multiple countries of this mark. In other words, Plaintiff’s claim that “Applicant lacked bona fide intent to use of the mark in commerce” is completely untrue.

Telephone: (787) 282-5701
Telecopier: (787) 753-8944
Email: mauricio.muniz@oneillborges.com
tmproceedings@oneillborges.com

[CERTIFICATES OF TRANSMISSION AND SERVICE ON FOLLOWING PAGES]

CERTIFICATE OF TRANSMISSION

I, Mauricio O. Muñoz Luciano, hereby certify that the foregoing *Applicant's Motion to Dismiss Opposition for Failure to State a Claim* is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on April 30, 2014.

By: /Mauricio O. Muñoz Luciano/
Mauricio O. Muñoz Luciano

O'Neill & Borges LLC
Attorneys for Ebel International Limited
250 Muñoz Rivera Ave., Suite 800
San Juan, PR 00918
Telephone: (787) 282-5701
Telecopier: (787) 753-8944
Email: mauricio.muniz@oneillborges.com
tmproceedings@oneillborges.com

CERTIFICATE OF SERVICE

I, Mauricio O. Muñiz Luciano, state that I served a true and complete copy of the foregoing ***Applicant's Motion to Dismiss Opposition for Failure to State a Claim***, via USPS First Class mail, postage prepaid, and email (jhgeller@aol.com) upon Opposer's counsel of record at the following address:

Jay H. Geller, Esq.
Jay H. Geller, A Professional Corporation
12100 Wilshire Bl. Suite 500
Los Angeles, CA 90025
UNITED STATES
Telephone: (310) 979-99966
Facsimile: (310)943-0430

On this 30th day of April 2014.

s/Mauricio O. Muñiz Luciano /
Mauricio O. Muñiz Luciano